

REMARKS/ARGUMENTS

Examiner's first rejection:

The Examiner has rejected claims 1, 4, and 5 as being unpatentable under 35 U.S.C. 102(b) based on Gibble (US 2,855,679) in lieu of Durst (2,822,615). Applicant disagrees with this rejection as indicated below.

First and foremost, the applicant notes that one of the elements, specifically element 1(d) of claim 1, states "mounting means for attaching the casing to the hand-held tool." It should be noted that although the Gibble prior art reference does disclose a casing and light combination, the casing is attached within the hand-held tool and is not attached to the hand-held tool. Therefore, one of the elements disclosed in the present invention is missing within the Gibble prior art reference, and thus, applicant believes he has successfully traversed this rejection.

Although Durst purports to disclose a casing attached to a hand-held tool, this patent is inapplicable because the prior art is way too old. Durst is a 1958 patent and is not current, and therefore, has been wrongfully combined with Gibble in an attempt to render claims 1 and 4-5 as "obvious."

Since claims 4-5 are derivative of claim 1 either directly or indirectly, the above-listed legal reasoning and analysis is believed to obviate this rejection for these claims as well.

Examiner's second rejection:

The Examiner has rejected claims 2-3 under 35 U.S.C. 103(a) based on Gibble (US 2,855,679) in view of Durst (US 2,822,615), and further in view of Snone et al. (US 5,797,670). Applicant disagrees with this rejection as indicated below.

Even if Gibble and Snoke et al. were combined as the Examiner has indicated, all of the claimed elements of the present invention would not be disclosed. As is clear from the specification and the accompanying claims, element 1(d) of claim 1, states “mounting means for attaching the casing to the hand-held tool.” It should be noted that although the Gibble prior art reference does disclose a casing and light combination, the casing is attached within the hand-held tool and is not attached to the hand-held tool. Therefore, one of the elements disclosed in the present invention is missing within the Gibble prior art reference. Applicant propounds it would not be “obvious” to automatically change the location of the casing and light combination to arrive at the present invention.

Although Durst purports to disclose a casing attached to a hand-held tool, this patent is inapplicable because the prior art is way too old. Durst is a 1958 patent and is not current, and therefore, has been wrongfully combined with Gibble in an attempt to render claims 2-3 as “obvious.”

Examiner’s third rejection:

The Examiner has rejected claim 6 under 35 U.S.C. 103(a) based on Gibble (US 2,855,679) in view of Durst (US 2,822,615), and further in view of Gassen et al. (US 5,016,355). Applicant disagrees with this rejection as indicated below.

Even if the two prior art references were combined as the Examiner has indicated, all of the claimed elements of the present invention would not be disclosed. As is clear from the specification and the accompanying claims, element 1(d) of claim 1, states “mounting means for attaching the casing to the hand-held tool.” It should be noted that although the Gibble prior art reference does disclose a casing and light combination, the casing is attached within the hand-

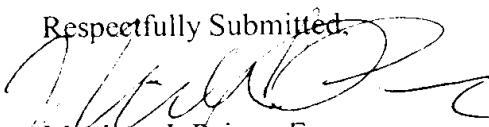
held tool and is not attached to the hand-held tool. Therefore, one of the elements disclosed in the present invention is missing within the Gibble prior art reference. Applicant propounds it would not be “obvious” to automatically change the location of the casing and light combination to arrive at the present invention.

Furthermore, the mere existence of a chain saw, as disclosed in the Gassen et al., would not be enough to automatically render the resulting combination in the present invention, as disclosed in claim 6, “obvious.” If this reasoning were upheld on this basis, each element of a particular claim for any application could merely be “picked out” of a different prior art reference, with the resulting combination declared obvious due to prior disclosure of each separate element. This type of analysis is inappropriate when looking at claims “as a whole.”

Furthermore, although Durst purports to disclose a casing attached to a hand-held tool, this patent is inapplicable because the prior art is way too old. Durst is a 1958 patent and is not current, and therefore, has been wrongfully combined with Gibble in an attempt to render claim 6 as “obvious.”

CONCLUSION

For all of the above-described reasons, applicant submits that the specifications and claims are now in proper form, and that the claims define patentability over the prior art. In addition, applicants believe that his arguments in the "Remarks" section successfully traverses the objections and rejections brought forth by the Examiner in the Office Action. Therefore, the applicant respectfully submits that this application is now in condition for allowance, which action he respectfully solicits. If the Examiner feels that some of the dependent claims are allowable, the Applicant asks the Examiner to allow the Applicant to make any amendments to the allowed claims to incorporate all the limitations of the base claim and any intervening claims.

Respectfully Submitted,

Matthew J. Peirce, Esq.
Registration No. #41,245
Attorney for Inventor Iram Casas